

**REMARKS**

The Final Office Action mailed July 1, 2004, has been received and reviewed. Claims 1 through 7, and 10 through 25 are currently pending in the application. Claims 16 through 25 stand rejected. Claims 1 through 7, and 10 through 15 have been allowed. Applicants propose to amend claim 16 and cancel claims 22-25, and respectfully request reconsideration of the application as proposed to be amended herein.

**35 U.S.C. § 103(a) Obviousness Rejections**

Obviousness Rejection Based on U.S. Patent No. 6,430,547 to Busche et al. and U.S. Patent No. 6,236,907 to Hauwiller et al. in view of U.S. Patent No. 6,026,399 to Kohavi et al.

Claims 16 through 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Busche et al. (U.S. Patent No. 6,430,547) and Hauwiller et al. (U.S. Patent No. 6,236,907) in view of Kohavi et al. (U.S. Patent No. 6,026,399). Applicants respectfully traverse this rejection, as hereinafter set forth.

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

The 35 U.S.C. § 103(a) obviousness rejections of claims 16-22 are improper because the elements for a *prima facie* case of obviousness are not met. Specifically, the rejection fails to meet the criterion that the prior art references must teach or suggest all the claim limitations.

Applicants submit that any proposed combination of the Busche reference in view of the Hauwiller reference and further in view of the Kohavi reference does not teach or suggest the claims limitations of Applicants' amended independent claim 16, from which claims 17-22

depend.

The *Response to Arguments* section of the Office Action states:

Examiner maintains that Hauwiller discloses the claimed “providing recommendations as to how to achieve a predetermined target. As noted by applicant Hauwiller discloses the that a user provides the recommendations. The claimed system does not specifically state who or what provides the recommendations. Therefore, Examiner maintains that the claimed invention is unpatentable. Additionally, Hauwiller discloses that *the user or expert system provides the recommendation* (col 3, lines 60-68).

... Applicant's claimed limitation of “using the estimation of . . .” is presented in alternative form. Examiner has meet the limitation of at least one alternative, specifically the claimed “providing recommendations”. Therefore, examiner maintains that the Claimed invention is unpatentable. (Office Action, pp. 2-3; emphasis added).

Applicants respectfully submit that a detailed reading of Hauwiller's “expert's system or user's recommendation” at the citation is subject to two separate interpretations, namely:

(1) being directed to discretion on input data and on processes that are performed on input data, when read as highlighted below:

The system 104 contains GIS software, which provides a system for handling spatial data for use in creating application maps 106, thereby enabling the system *to input data, manipulate the input data, and perform mathematical and spatial calculations along and through different types of data based on an embedded expert system's or user's recommendations* for producing application treatment maps as will be described in further detail herein. (Col. 3, lines 60-67; emphasis added).

or

(2) the Examiner's citation may alternatively be read to teach as being directed to discretion on whether to produce application treatment maps as an output, when read as highlighted below:

The system 104 contains GIS software, which provides a system for handling spatial data for use in creating application maps 106, thereby enabling the system to input data, manipulate the input data, and perform mathematical and spatial calculations along and through different types of data *based on an embedded expert system's or user's recommendations for producing application treatment maps* as will be described in further detail herein. (Col. 3, lines 60-67; emphasis added).

In either interpretation, the “recommendations” are NOT drawn to Applicants' use of

“recommendations”, as claimed in Applicants’ independent claim 16, namely,

16. In a networked computer system that includes a client and a server, wherein the server maintains spatial data sets, a method for analyzing the spatial data sets over the network, ***the method*** comprising the steps for:

applying spatial data mining functions to the spatial data sets, the spatial data sets generated using identified attributes selected by a user, wherein said spatial data mining functions comprise the steps for modeling the spatial data sets to provide estimation of

predetermined parameters at predetermined points; and classifying the spatial data sets into predetermined classes; and ***using the estimation of the predetermined parameters to*** accomplish a predetermined purpose, wherein the predetermined purpose includes at least one of determining how a predicted variable affects a predetermined target variable, ***generating recommendations*** as to how to achieve a predetermined target variable.

Therefore, Applicants respectfully submit that Applicants’ invention as claimed in amended independent claim 16 distinguishes over either interpretation of the teachings of the Hauwiller reference. In response to the Examiner’s comments that “The claimed system does not specifically state who or what provides the recommendations” (Office Action, pp. 2-3), Applicants have amended claim 16 to make explicit the inherent “generated” nature of the recommendations in contrast to “recommendations” received by human or user intervention.

Furthermore, Applicants submit that any proposed combination of the Busche reference, the Hauwiller reference and the Kohavi reference does not teach or suggest portions of the other claim limitations calling for “using the estimation of the predetermined parameters to accomplish a predetermined purpose, wherein the predetermined purpose includes at least one of determining how a predicted variable affects a predetermined target variable, ***generating recommendations as to how to achieve a predetermined target variable.***”

The Office Action addresses the predetermined purpose of determining how the predicted variable affects a predetermined target variable. However, Applicants do not see that the cited references (namely Hauwiller col. 4, lines 36-40, lines 48-52, lines 23-26, and lines 5-35)

supporting the rejection of this element of claim 16 address the other predetermined purposes of “generating recommendations as to how to achieve a predetermined target variable.”

Applicants submit that a prior art reference must be considered as a whole including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 USPQ 303 (Fed. Cir. 1983). Hauwiller teaches,

recommendation equations or application rate equations are formulas which express the relationship between existing field conditions and desired output. The expert system 216 may utilize pre-defined recommendation equations as illustrated by block 226 or user specified recommendations as indicated by block 208b for correlating desired data relative to desired output (col. 9, lines 16-22).

Both “pre-defined recommendation equations” and “user specified recommendations” suggests *a priori* development of the recommendations. As a result, Hauwiller would suggest against, or at least lead away from, “using the estimation of predetermined parameters to accomplish . . . generating recommendations as to how to achieve a predetermined target variable.” In other words, the prior art suggests using pre-defined recommendations rather than the present inventions claim of generating recommendations as to how to achieve a target variable as part of the result of the spatial data mining process.

Additionally, Applicants can find nothing in the cited references of Hauwiller, Busche, or Kohavi, teaching, “using the estimation of the predetermined parameter to accomplish a predetermined purpose, wherein the predetermined purpose includes at least one of determining how the predicted variable affects a predetermined target value . . .”

Therefore, Applicants respectfully request the rejection of amended independent claim 16 and claims 17-22 depending therefrom be withdrawn.

Regarding claims 23-25, Applicants have cancelled claims 23-25, without prejudice, for accelerating allowance of the currently pending patent application and reserve the right for prosecuting the cancelled claims in any continuation patent application.

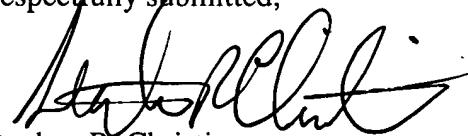
### ENTRY OF AMENDMENTS

The proposed amendments to claim 16 above should be entered by the Examiner because the amendments are supported by the as-filed specification and drawings and do not add any new matter to the application. Further, the amendments do not raise new issues or require a further search. Finally, if the Examiner determines that the amendments do not place the application in condition for allowance, entry is respectfully requested upon filing of a Notice of Appeal herein.

### CONCLUSION

Claims 1-7 and 10-15 were allowed. Claims 16-22 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, the Examiner is respectfully invited to contact Applicants' undersigned attorney.

Respectfully submitted,



Stephen R. Christian  
Registration No. 32,687  
Attorney for Applicants  
P.O. Box 1625  
Idaho Falls, ID 83415-3899  
Phone: (208) 526-9140  
Fax: (208) 526-8339

Date: 19 Aug 2004